

Appln No. 10/758,762
Amdt date November 22, 2006
Reply to Office action of July 25, 2006

REMARKS/ARGUMENTS

Claims 1, 5-15, 17 and 19-37 are currently pending in the present application, of which claims 1, 17 and 33 are independent. Claims 1 and 17 are amended herein. New claims 35-37 have been added. No new matter has been added. None of the claims has been canceled herein. Applicant respectfully requests reconsideration and allowance of claims 1, 5-15, 17 and 19-34. Applicant also requests that claims 35-37 be considered on the merits and be allowed. Applicant thanks the Examiner for the thorough review of the application. Applicant responds to each point raised by the Examiner in the July 25, 2006 Office action as follows:

I. Priority

The Examiner appears to object to the certified copy of the foreign priority document because there allegedly is only an indication of the applicant and not the inventor. According to the Examiner, this can be addressed by providing a translation of that portion of the certified copy of the foreign priority document that names the inventor. Applicant appreciates the Examiner's guidance. Please find attached hereto a translation of pages 21-1 and 21-2 of the priority document (Korean Application No. 20-2003-0001544) that includes bibliographic information. Also enclosed is a Certification/Verification of translation signed by the attorney of record, who is fluent in both English and Korean.

II. Oath/Declaration

According to the Office Action, "[t]he oath or declaration of record infers that the inventor filed the foreign application; however, the translated portion of the certified copy of the foreign priority document indicates that the applicant was Caravan International Co., Ltd. As the Examiner is probably aware, in most foreign countries including Korea, it is customary to file patent applications with the assignee or employer as the applicant. The translated pages 21-1 and 21-2 clearly indicate that Dong Woog SEO is the inventor.

According to MPEP § 201.13(II)(C) cited by the Examiner:

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The inventors of the U.S. nonprovisional application and of the foreign application must be the same, for a right of priority does not exist in the case of an application of inventor A in the foreign country and inventor B in the United States, even though the two applications may be owned by the same party. However, the application in the foreign country may have been filed by the assignee, or by the legal representative or agent of the inventor which is permitted in some foreign countries, rather than by the inventor himself, but in such cases the name of the inventor is usually given in the foreign application on a paper filed therein. An indication of the identity of inventors made in the oath or declaration accompanying the U.S. nonprovisional application by identifying the foreign application and stating that the foreign application had been filed by the assignee, or the legal representative, or agent, of the inventor, or on behalf of the inventor, as the case may be, is acceptable. . . (emphasis added)

Since the foreign priority application, namely, Korean application no. 20-2003-0001544, already indicates the name of the inventor as Dong Woog SEO, Applicant does not believe any further indication of inventorship for the priority application is required in Oath or Declaration. Further, the Korean Language Declaration filed in the present application is the official PTO form, PTO/SB/110 (05-95), and is believed to be non-defective. In view of the above, Applicant respectfully requests that any objection to Oath/Declaration be withdrawn.

III. Drawings

The drawings filed May 2, 2006 were objected to allegedly because "FIGS. 7 and 10-17: They fail to comply with 37 CFR 1.84(p)(1) which prohibits reference characters used in association with inverted commas, i.e., quotation marks. In the present application, applicant has used single, double, and triple marks in association with various reference characters." However, 37 CFR 1.84(p)(1) appears to pertain to "enclosing" reference numerals within the inverted commas or quotation marks, such as "100". By way of example, in 37 CFR 1.84(p)(1), the "inverted commas" are referenced together with "brackets" and "enclosed within outlines." From the context of this CFR section, it appears clear that the inverted commas refer to uses such as '100' or "100" and not 100', 100" or 100"". Therefore, Applicant requests that the objection to the drawings be withdrawn without requiring amendment to the drawings.

IV. Rejection of Claims 1, 5-13, 15, 17, 19-27, 29, 30, and 34 under 35 U.S.C. § 103(a)

Claims 1, 5-13, 15, 17, 19-27, 29, 30, and 34 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Suh ("Suh" U.S. Patent No. 6,478,039) in view of Leung ("Leung" U.S. Patent No. 5,056,291) and Chapman ("Chapman" U.S. Patent No. 5,024,251).

Independent claim 1 has been amended herein, and it now recites, in a relevant portion, "wherein the cover comprises a resilient compression element that extends into the opening to press against said side surface of said corresponding one of the uprights when the cover is in the closed position." (Emphasis Added)

Chapman discloses a "gasket 50 [that] is compressed against the top and edge of the joint connectors 16 when the cover 14 is closed." See Col. 3, lines 25-27 (Emphasis Added). Chapman thus does not disclose a "resilient compression element" that "extends into the opening," and instead, Chapman discloses a gasket that rests on the edges of the cover, and does not extend into the wireway. Thus, the gaskets in Chapman are compressed between the edges of the cover and those of the wireway without extending into the wireway. This is necessary to the invention of Chapman because the gaskets exist to "provide resilient pressure on the cover 14 and joint connector 16" to create an "oiltight seal" around the edges of the wireway rather than to make contact with an object internal to the wireway. See Col. 3, lines 39-40; Col. 3, lines 10-16.

In the present application, however, the resilient member extends into the opening to be pressed between the cover and the upright in order to hold the mounting bracket in place with respect to the upright. The gasket in Chapman, on the other hand, presses against the edges of the cover and the corresponding edges of the wireway to create an oiltight seal, and not to make a contact with an object internal to the wireway. Thus, Chapman does not teach a resilient compression member that extends into the opening to press against upright to more securely hold the mounting bracket with respect to the upright.

In order to establish a *prima facie* case of obviousness, in addition to meeting all of the other requirements, the cited references together must teach or suggest all elements of a claim. Since Suh, Leung, and Chapman together fail to teach or suggest a "resilient compression element that extends into the opening," these references together do not teach or suggest all

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elements of claim 1. Hence, claim 1 would not have been obvious over Suh, Leung, and Chapman at the time the invention was made. Therefore, Applicant requests that the rejection of claim 1 be withdrawn and that it be allowed.

Additionally, even if Suh, Leung, and Chapman together taught or suggested all of the elements of claim 1, which they do not, Chapman is not analogous art to a "side rail assembly for a canopy having a plurality of uprights" for the purposes of 35 U.S.C. § 103(a). Instead, Chapman concerns lay-in wireways used to completely enclose electrical cables in order to protect them from contamination by dust, water, or oil.

Chapman discloses an "oiltight lay-in wireway comprised of wireway sections with hinged covers and a joint connector between the covers of two adjacent wireway sections." *See* Abstract. Chapman also discloses "a gasket 50 [that] is compressed against the top and edge of the joint connectors 16 when the cover is closed." *See* Col. 3, lines 25-27. Chapman further discloses that "[t]he clip extension 62 is then lowered to cause the finger 58 to exert a downward force on the cover 14 and also on the joint connector 16, compressing their associated gaskets to provide an oil-tight assembly." *See* Col. 3, lines 33-37 (Emphasis Added).

Chapman makes use of a gasket not for the purpose of holding an object in place, unlike the resilient compression element in embodiments of the present application, but instead as a sealant to prevent dust, water, oil, or other debris from entering the wireway. The invention in Chapman uses the gasket to create an oil-tight seal along the edges of the cover by applying "a uniform pressure along the joint connector gaskets 36." *See* Col. 3, lines 54-55. Thus, even if Chapman, combined with Suh and Leung, contained all of the elements of claim 1, which they do not, there would be no motivation to combine the teachings of Chapman with Suh or Leung as it is not analogous art.

Finally, even assuming that Suh, Leung, and Chapman disclose every element of claim 1, which they do not, Applicant still respectfully submits that the rejection of claim 1 is improper in this case. It is well settled that a *prima facie* case of obviousness cannot be established by merely locating references which describe various aspects of a patent applicant's invention. The Examiner must also "show some objective teaching in the prior art . . . that would lead [one of

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ordinary skill in the art] to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 7074 (Fed. Cir. 1988); *see also Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1302 (BPAI 1993). Moreover, when the references do not explicitly provide such motivation, "[t]he test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000) as quoted in MPEP 2143.01.

Because Chapman concerns lay-in wireways used to completely enclose electrical cables in order to protect them from contamination by dust, water, or oil, it is not analogous to a "side rail assembly for a canopy having a plurality of uprights" as discussed above, and a person having ordinary skill in the art would therefore have no motivation to combine its teachings with the teachings in the field of the present invention. Hence, claim 1 would not have been obvious over Suh, Leung, and Chapman at the time the invention was made. Therefore, Applicant requests that the rejection of claim 1 be withdrawn and that it be allowed.

Independent claim 17 now recites, in a relevant portion, "a first side rail connector having a post, wherein the hook engages the post to secure the side rail to the mounting bracket, wherein the cover comprises a resilient compression element that extends into the opening to press against said side surface of said corresponding one of the uprights when the cover is in the closed position." For reasons that are substantially the same as those given above in reference to claim 1, claim 17 is patentably distinguishable over the cited references. Therefore, Applicant requests that the rejection of claim 17 be withdrawn and that it be allowed.

Since claims 5-13, 15, 19-27, 29, 30, and 34 all depend, either directly or indirectly, from claim 1 or claim 17, these claims each incorporate all the terms and limitations of claims 1 or 17, in addition to other elements, which together further patentably distinguish them over the cited references. Therefore, Applicant requests that the rejection of claims 5-13, 15, 19-27, 29, 30, and 34 under 35 U.S.C. § 103(a) be reconsidered and withdrawn and that these claims be allowed.

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V. Rejection of Claims 14 and 28 under 35 U.S.C. § 103(a)

Claims 14 and 28 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Suh in view of Leung and Chapman in further view of Ruppel ("Ruppel" U.S. Patent No. 2,001,215). Ruppel is being cited for the proposition that it teaches a "connector for 90- and 180-degree arrangements for rails (18, 22) that are arranged perpendicularly and axially," and does not overcome the deficiencies of Suh, Leung, and Chapman to reject claims 1 and 17. Therefore, claims 1 and 17 are patentably distinguishable over Suh, Leung, and Chapman in view of Ruppel. Since claims 14 and 28 respectively depend indirectly from claims 1 and 17, they incorporate all the terms and limitations of claim 1 or claim 17 in addition to other elements, which together further patentably distinguish them over the cited references. Therefore, Applicant requests that the rejection of claims 14 and 28 under 35 U.S.C. § 103(a) be reconsidered and withdrawn, and that these claims be allowed.

VI. Rejection of Claims 31 and 32 under 35 U.S.C. § 103(a)

Claims 31 and 32 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Suh in view of Leung and Chapman in further view Delp ("Delp" U.S. Patent No. 2,897,013). Delp is being cited for the proposition that it "teaches a structural member for a collapsible frame that is comprised of a plurality of sections (E.1, E.2) connected together via a support connector (10b). The sections and connector enable the frame to be collapsed to a shorter dimension for transporting and/or storing," and does not overcome the deficiencies of Suh, Leung, and Chapman to reject claim 17. Since claims 31 and 32 depend, directly or indirectly, from claim 17, they each incorporate all the terms and limitations of claim 17, in addition to other limitations, which together further patentably distinguish them over the cited references. Therefore, Applicant requests that the rejection of claims 31 and 32 under 35 U.S.C. § 103(a) be reconsidered and withdrawn, and that these claims be allowed.

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VII. Rejection of Claim 33 under 35 U.S.C. § 103(a)

Independent claim 33 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Suh in view of Leung, Chapman, and Carter ("Carter" U.S. Patent No. 6,041,800).

Chapman is being cited for the proposition that it "teaches a cover that includes a resilient compression member (gasket 50) that presses against an adjacent element to more securely hold the cover in place with respect to the adjacent element." Further, Carter is being cited for the proposition that it "teaches telescoping uprights (FIG. 7-8) for a collapsible canopy frame having a set of edge scissor assemblies." The Examiner also contends that "Chapman is analogous art because it is related to the frictional engagement of a cover with an adjacent element." First of all, as discussed above in reference to claim 1 in Section IV, Chapman is not analogous prior art.

Further, claim 33 recites, in a relevant portion, "a mounting bracket mounted on a corresponding one of the uprights, wherein the mounting bracket comprises a first side rail connector having a post, and wherein the hook engages the post to secure the side rail to the mounting bracket, wherein the mounting bracket has a resilient member on a surface abutting the corresponding upright, such that the mounting bracket is frictionally secured to a side surface of the corresponding upright."

As discussed above in reference to claim 1 in Section IV, Chapman makes use of a gasket not for the purpose of holding an object in place, as in the present application, but instead as a sealant to prevent dust, water, oil, or other debris from entering the wireway. Therefore, there is no teaching, suggestion or motivation to combine Chapman with Suh, Leung and Carter or with any other reference to practice the claimed embodiments of the present application. Therefore, Applicant submits that a *prima facie* case of obviousness cannot be established for claim 33 over Suh, Leung, Chapman and Carter. Accordingly, Applicant requests that the rejection of claim 33 under 35 U.S.C. § 103(a) be reconsidered and withdrawn, and that the claim be allowed.

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VIII. New Claims 35-37

New Claims 35-37 have been added.

Claim 35 recites "[t]he side rail assembly of claim 1, wherein the cover has an opening defined therein, and wherein the resilient compression element is mounted in the opening of the cover."

Claim 36 recites "[t]he side rail assembly of claim 17, wherein the cover has an opening defined therein, and wherein the resilient compression element is mounted in the opening of the cover."

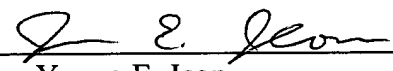
Claim 37 recites "[t]he collapsible canopy frame of claim 33, wherein the mounting bracket has an opening defined in the surface abutting the corresponding upright, and wherein the resilient member is mounted in the opening defined in the surface."

Since none of the cited references teach or suggest that "the cover has an opening defined therein, and wherein the resilient compression element is mounted in the opening of the cover" or that "the resilient member is mounted in the opening defined in the surface," Applicant requests that claims 35-37 be allowed.

IX. Concluding Remarks

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application, including claims 1, 5-15, 17, and 19-37, is in a condition for allowance, and accordingly, requests a timely issuance of a Notice of Allowance. If there are any remaining issues that can be addressed over the telephone, the Examiner is cordially invited to call Applicant's attorney at the number listed below.

Respectfully submitted,
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